REMARKS

Cancellation of claims and amendment to claims has been made to overcome the Examiner's objections and rejections under 35 USC 112, first paragraph.

The Examiner has rejected claims 1-4, 8-11 and 15-18 under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,736,938 to Evvard, et al. The Applicants submit that amendment to independent claims 1, 8 and 15 clearly distinguishes the present invention over Evvard, et al.

It has long been established that only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of the claimed invention is there anticipation. RCA Corp. v. Applied Digital Data Systems, Inc. 221 USPQ 385 (Fed. Cir. 1994).

Bearing in mind this criteria, the amended claims include a second instrument having a tool tip for manipulating a cataract as the cataract is being removed. This claim language is found in the original specification on page 8, line 32 and shown in Figures 5-8.

Clearly, the Evvard, et al. reference does not show, suggest or hint the use of a second instrument which includes a tool tip for manipulating a cataract as the cataract is being removed. Thus, the Applicants submit that a rejection under 35 USC 102(d) on the basis of the Evvard, et al. reference cannot be supported and the Examiner is respectfully requested to withdraw the rejection of claims 1-4, 8-11 and 15-18.

Claims 5, 7, 12, 14, 19 and 21 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over the Evvard, et al. reference in view of U.S. 6,454,663 to Motter, et al. In this rejection the Examiner states that Evvard, et al. teaches the apparatus in accordance with claim 15 but fails to disclose a plurality of irrigation ports. Therefore, the Examiner reaches to Motter, et al. for a disclosure of a plurality of "ports" (side holes) 52 for introducing an irrigation fluid to "provide a source of critical fluid flow to the cervical cite" (col. 9, lines 34-45). Examiner then concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to add ports/side holes as taught by Motter, et al. to Evvard, et al.'s second instrument.

It should be noted that there is no teaching in Motter, et al. of a second instrument having a tool tip for manipulating a cataract as a cataract is being removed by a first instrument. Thus, the Applicant submit that claims 5, 7, 12, 14, 19 and 21 are patentable over the combination suggested by the Examiner.

With regard to the plurality of irrigation ports, the Applicants submit that while multiple ports are shown by Motter, et al. in combination with the laser surgical handpiece, there is a failure to show in the combination references any suggestion of utilizing multiple ports in a second instrument which includes a tool tip for manipulating a cataract being removed by a first instrument. Accordingly, the Applicants submit that the Examiner has not made a prima facie case of obviousness.

The Examiner also recognizes that Evvard, et al. fails to disclose a tip comprising a blade but then assumes it would have been obvious to one of ordinary skill in the art that at the time the invention was made to add a blade to the tip of the second instrument to assist in emulsifying.

The Applicants respectfully submit that this statement is an Examiner's opinion. It has been established that factually unsupported opinions of the Examiner do not provide the basis required by the Supreme Court in the Deere case (148 USPQ 459, 1966) for the determination of obviousness under Section 103 (in re Wagner and Folkers) 152 USPQ 552 (CCPA 1967).

That is, the Examiner has failed to produce any objective evidence to support the conclusion that one having ordinary skill in the art at the time the invention was made would add a blade to the tip of the second instrument to assist in emulsifying.

The Applicants submit that it is only the Applicants disclosure which has motivated the Examiner to conclude that the present invention is obvious. However, the Applicants submit that in determining patentability of claims, it is required by 35 USC 103 to do so from a vantage point of one having ordinary skill in the art and then to determine whether the claimed invention would have been obvious to such a person at the time the invention was made without reading into that art the teaching of the Applicants invention. In re Sporck 133 USPQ 360 (CCPA 1962).

Thus, while it might be possible to select statements from references and mechanically combine them with other references to arrive at the Applicants claimed combination, there is no basis for making the combination since neither of the references is directed to a problem solved by the Applicants invention. Only the Applicants specification suggests any reason for combining the teachings of the prior art but the use of such suggestion is improper under 35 USC 103. In re Pye and Peterson 148 USPQ 426 (CCPA 1966).

The problem solved by the present invention is the difficulty in removing a cataract with one instrument, namely a vibrated needle. The solution is the combination of a second instrument having a tool tip for manipulating the cataract as it is being removed.

The teachings of the references provide no structure similar to that of the Applicants which functions in a manner similar to the tool instruments of the Applicants which results in facilitating the removal of a cataract from an eye. The Applicants respectfully request the Examiner to withdraw the rejection of claims 5, 7, 12, 14, 19 and 21 under 35 USC 103(a) on the basis of the Evvard, et al. and Motter, et al. references.

In view of the amendment to the claims and the arguments hereinabove set forth, it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectively requested.

Respectfully submitted,

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(DATE SIGNED)

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